

affixed along a lowermost seam of the collection receiver, said receiver discharge in fluid communication with the internal volume of the collection receiver; and

a discharge valve terminating said receiver discharge for controllably releasing the contents of the collection receiver.

### REMARKS

Reconsideration of the application as amended is respectfully requested.

Claims 1, 2, 4, 5, 7, 8 and 9 were rejected under 35 USC 102(e) as being anticipated by *Edwards*. In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102, a primary tenet is that only the CLAIMED designs are to be compared. Many differences exist between the design claimed in *Edwards* and the currently claimed design. To briefly summarize the distinguishing features and characteristics of each, *Edwards* claims a urine container in combination with a floatation tube in which one of the sidewalls of the urine container is formed with the sidewall of the floatation device. Further, an attachment device is connected for attaching the device to the user.

The present invention includes a number of features that are unanticipated in the above mentioned references. These include:

- a kit configuration;
- including a series of specifically adapted collector funnels each forming a collector receiver;
- each collector funnel being interchangeable;
- wherein said collector funnels include a male collector funnel; and

a female collector funnel.

These are features undisclosed and unanticipated in the art.

Accordingly, the rejection by the examiner under 35 U.S.C. 102(e) is inappropriate.

Further, claim 3 was rejected by the examiner under 35 U.S.C. 103 (a) as being unpatentable over *Edwards* in view of *Young et al.* Also, Claim 6 was rejected under 35 U.S.C. 103 (a) as being unpatentable over *Edwards* in view of *Rower et al.* and claim 10 was rejected as being unpatentable over *Edwards* in view of *Levine et al.*

*Young et al.* discloses, in essences, an ostomy pouch and claims only a method for sequestering fluid in a bag. *Rower* discloses a venturi cleaning system and claims a method for cleaning medical devices such as urinary drainage systems, colostomy systems, and the like.

And, *Levine et al.* discloses and claims only a urinary collection device for human females.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument application wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter

Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of making an emergency urinal kit consists of a small rubber collection funnel, attached to a connecting hose and an inlet valve and having an air relief valve and an exit valve on the bottom. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

The Court of Appeals for the Federal Circuit (CAFC) in its opinion in In re Fine, 837

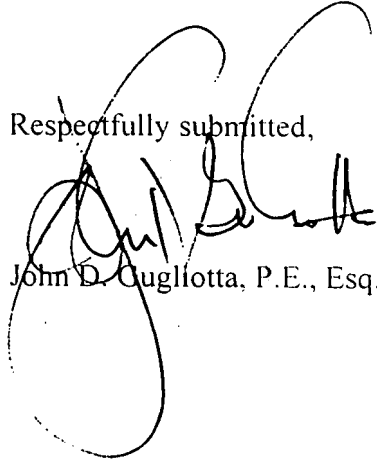
F.2d. 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988), (later upheld in In re Dance, 160 F.3d. 1339, 48 USPQ 2d. 1635 (Fed. Cir. 1998), sets forth the test of how the disclosure or teaching of references should be applied under 35 USC §103:

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d. 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so". Id., Here, the prior art contains none. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,

  
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